UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,015	07/20/2001	Kazuhiro Sugawara	35.C15592	9096

5514 7590 12/22/2006	EXAMINER
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	ART UNIT | PAPER NUMBER
	2144

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	09/909,015	SUGAWARA, KAZUHIRO
	Examiner	Art Unit	
	Paul H. Kang	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>49-72</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>49-72</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>20 July 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   Examiner Michael A. Delgado is no longer assigned to the present patent application.

This application is now assigned to Examiner Paul H. Kang. In examining this patent

application, full faith and credit has been given to the search and action of the previous examiner.

MPEP § 719.05.

Status of Claims

2.   Claims 1-48 have been cancelled. Claims 49-72 are newly added. Claims 49-72 are now

pending.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

4.   **Claims 49-72 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent**

No. 6,073,142 to Geiger et al..

5.   As to claim 49, Geiger teaches a communication apparatus which is connected to an E-

mail server via a network, said communication apparatus comprising (Fig 1,102):

        a receiving unit (Fig 3, 282), adapted to receive an E-mail which is to be sent to said

communication apparatus stored in a mailbox provided on an E-mail server (Col 11, lines 1-

10);

        a first obtaining unit (Fig 2, 200), adapted to obtain attribute information of the E-mail

stored in the mailbox (Col 3, lines 40-50) (Col 6, lines 20-25) (Col 6, lines 50-60) (Col 10,

lines 30-40);

        a discriminating unit (Fig 2, 210), adapted to discriminate whether or not to receive the

E-mail before said receiving unit receives the E-mail based on the attribute information

obtained by said first obtaining unit (Col 10, lines 30-40);

        wherein, in a case where said discriminating unit discriminated to receive the E-mail,

said receiving unit receives the E-mail that said discriminating unit discriminated to receive,

and in a case where said discriminating unit discriminates not to receive the E-mail, said

receiving unit does not receive the E-mail that said discriminating unit has discriminated not to

receive (Col 7, lines 1-10); and

        wherein said discriminating unit further discriminates whether or not to receive an E-

mail other than the E-mail that said discriminating unit has discriminated not to receive (Col

10, lines 30-40).

6.   As to claims 50 and 59, Geiger teaches the communication apparatus further comprising

a controlling unit (Fig 2, 230), adapted to, in a case where said discriminating unit discriminated

not to receive the Email, send to the E-mail server an instruction for deleting from the mail box

the E-mail that said discriminating unit discriminated not to receive, and to delete E-mails after

the receiving unit receives that E-mail (Fig 4,422) (Col 10, lines 50-55).

7.   As to claim 51, Geiger teaches a communication apparatus wherein said first obtaining

unit obtains size information of the E-mail as the attribute information, and said discriminating

unit discriminates whether or not to receive the E-mail based on the obtained size information

(Col 3, lines 40-50) (Col 10, lines 30-40).

8.   As to claim 52, Geiger teaches a communication apparatus further comprising a second

obtaining unit, adapted to obtain maximum value information of a size of the E-mail capable of

being received by said receiving unit (Col 3, lines 40-50), wherein said discriminating unit

discriminates whether or not to receive the E-mail by comparing the size information of the E-

mail obtained by said first obtaining unit with the maximum value information obtained by

said second obtaining unit (Col 3, lines 40-50) (Col 10, lines 30-40).

9.   In claim 53, Geiger teaches a communication apparatus wherein said controlling unit

receives only header information of the E-mail that said discriminating unit discriminates not

to receive, and stores, as communication history information, information obtained from the

received header information (Col 3, lines 40-50) (Col 17, lines 15-25) (Col 23, lines 1-5).

Discrimination that is made base on sender is extracted from the source address of the header.

10.   In claim 54, Geiger teaches about a communication apparatus wherein said controlling

unit stores as communication history information the size information of the E-mail that said

discriminating unit discriminates not to receive (Fig 14) (Col 10, lines 50-55) (Col 23, lines 1-

5).

11.   In claim 55, Geiger teaches about a communication apparatus according to Claim 23,

wherein said controlling unit stores as communication history information a fact that the

reception by said receiving unit to the E-mail that said discriminating unit discriminates not to

receive is stopped (Fig 14) (Col 10, lines 50-55) (Col 23, lines 1-5).

12.   In claim 56, Geiger teaches about a communication apparatus wherein said controlling

unit stores as communication history information a fact that the E-mail that said discriminating

unit discriminates not to receive is deleted (Fig 14) (Col 10, lines 50-55) (Col 23, lines 1-5).

13.   In claim 57, Geiger teaches about a communication apparatus wherein, in a case where

said receiving unit receives the E-mail that said discriminating unit discriminates to receive,

said controlling unit stores as communication history information the information obtained

from the E-mail received by said receiving unit (Fig 14) (Col 10, lines 50-55) (Col 23, lines 1-

5).

14.   In claim 58, Geiger teaches about a communication apparatus further comprising an

output unit, adapted to, in a case where said receiving unit receives the E-mail that said

discriminating unit discriminates to receive, output the E-mail received by said receiving unit

(Col 10, lines 50-55).

15.   Claims 60-70 are the methods to the apparatus of claims 49-59 respectively, and are

rejected under the same rationale as claims 49-59.

16.   Claim 71 is the program for causing a computer to execute the apparatus of claim 49 is

rejected for the same reason as claim 49.

17.   Claim 72 is the computer-readable storage medium which stores a program used by a

computer to execute the method of the apparatus of claim 49 is rejected for the same reason as

claim 49.

18.   In claim 47, Geiger teaches about a communication apparatus according to Claim 23,

wherein, said controlling unit sends to said E-mail server an instruction for deleting from the

mail box the E-mail that said discriminating unit discriminated to receive (i.e. forwarding),

after said receiving unit receives the E-mail that said discriminating unit discriminated to receive

(Col 10, lines 50-60).

19.   In claim 48, Geiger teaches about a communication method according to Claim 34,

wherein, said controlling step includes sending to said E-mail server an instruction for deleting

from the mail box the E-mail that said discriminating step discriminated to receive (i.e.

forwarding), after the Email that said discriminating unit discriminated to receive is received in said receiving step (Col 10, lines 50-60).

Response to Arguments

20.   Applicant's arguments with respect to claims 49-72 have been considered but are moot in view of the new ground(s) of rejection. However, in an attempt to advance prosecution of this patent application, the following issue is addressed:

The applicants argue in substance that:

> "[I]t should be noted that the Geiger system discriminates the action to be applied, only *after* receiving all the E-mails. Applicant submits that this dies not suggest Applicant's apparatus recited in Claim 49, whose receiving unit receives a given E-mail only after the discriminating unit has made a discrimination about that E-mail. Applicant submits that it is apparent from this that the *Geiger* system cannot provide the benefit of the apparatus of Claim 49, to prevent receivable E-mails being needlessly left in the mail server merely because one E-mail in the mail box is not receivable." See Response, page 12.

21.   In response to applicant's argument that the *Geiger* patent fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It appears the applicants contend the claims are limited to said "receiving step" being the step of transferring the email message from the server to the client computer. However, the claims are not limited to this narrow reading. The "receiving step," as recited in the claims, may refer to the step of releasing or routing the message to a specified recipient after a discriminating step, i.e. after having received the email from the server, the message is not released/routed to the recipient prior to a discriminating step (See Geiger, Fig. 4A, 408). Because Geiger teaches
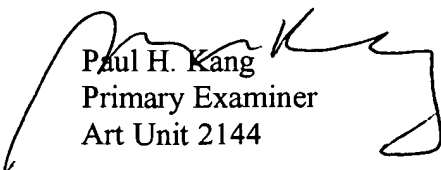
"releasing/routing" the message to the recipient after discriminating, it is deemed to anticipate

the invention as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The

examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul H. Kang
Primary Examiner
Art Unit 2144